

**REMARKS**

Reconsideration is respectfully requested in view of Applicant's amendment, remarks herein and 37 C.F.R. 1.132 Declaration enclosed herewith.

First, Applicant appreciates the allowability of claim 12. Since claim 17 is canceled at this time, the only claim remaining for consideration is claim 1, which will be discussed in detail hereinbelow.

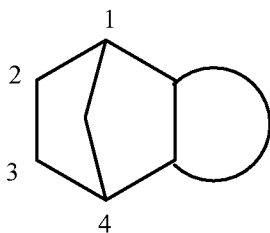
Prior to considering the prior art rejections of claim 1, the Examiner is kindly requested to note the corrections made in the specification at this time with respect to Referential Examples No. 1 and 2 on page 26 of the application, concerning the nomenclature for the produced deuterated compound. In both of these examples, the inherent primary product is the deuterated tricyclo decane-3-ol, and not the recited dec-3-en-8-ol. Correction is appropriate and does not raise any new matter issues, since the product of the two examples is still the same product, as being inherently produced, but was merely mis-named. An error in nomenclature is correctable where, as here, the resultant compound remains the same, but only incorrect nomenclature was employed in drafting the specification. In fact, in the Example No. 1 beginning at the middle of page 27 of the specification, the correct nomenclature for the product of Referential Example No. 2 was employed in the second line of the example, that is, 38.1 g. of the deuterated tricyclo decane-8-ol obtained by Referential Example No. 2 was employed as the starting material. Entry of the amendments to the specification is respectfully requested.

In paragraph 6 of the Office Action, claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawai et al in view of Koike; in paragraph 7 of the Office Action, claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takase et al in view of Koike.



In the above rejections, the Examiner takes the basic position that the product defined in claim 1 is obvious over the references regardless of how it is produced, bearing in mind that claim 1 is a product-by-process claim dependent upon the process of claim 12.

Next, the Examiner is respectfully requested to reference the amendment to claim 1. As the Examiner will note, amended claim 1 includes the subject matter “a binding site of  $R^4$  is at a 2- or 3-position of said norbornane ring.” The 2- or 3-position of the norbornane ring is as follows:

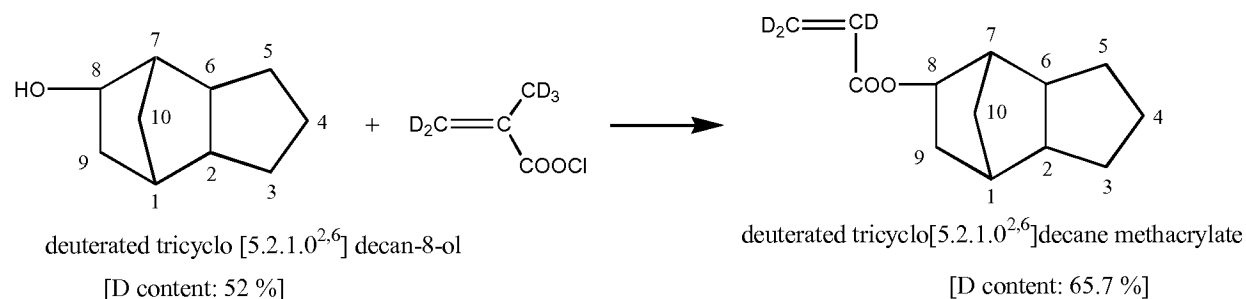


The specification inherently includes a description of “a binding site of  $R^4$  is at a 2- or 3-position of said norbornane ring.” Please see the Examples described in the specification at pages 25-28, including Example No. 1 and the two preceding Referential Examples.

As shown in the following synthesis scheme, it can be seen that the compound, prepared in Example 1, has  $R^4$  of which binding sites are the 2- or 3-position of the norbornane ring. (Please note that the numbering of 2- or 3-position, shown above, is for indicating the position of the norbornane single ring, and that the numbering of 1-10 positions, shown in the following scheme, is for indicating the position of the condensed ring. Therefore the mismatch between the two numberings is not unnatural.



Example 1



Therefore, the description of the specification, especially Example 1, inherently supports the amendment to claim 1.

Returning to the two prior art rejections, Applicant submits that the compounds of claim 1 could not have been prepared by any prior art process known at the time of the making of the present invention, particularly because of the binding site for R<sup>4</sup> as set forth in amended claim 1. With respect to forming the product of claim 1 having the defined binding site, out of the three references being applied in the two prior art rejections, Applicant submits that it is only the Kawai et al reference that sets forth a synthetic method for producing a non-deuterated tricyclo[5.2.1.0<sup>2,6</sup>] deca-8-yl (meth)acrylate through an esterification reaction beginning with the corresponding deca-8-ol. As explained in detail in the enclosed 1.132 Declaration, the prior art only teaches a method for making a deuterated condensed-aliphatic-ring alcohol, which is adamantanol-d15, which contains the hydroxyl substituent at the 1-position of the norbornane ring, all as explained in detail in the enclosed 132 Declaration. Since a deuterated condensed-aliphatic-ring alcohol containing the norbornane ring having a hydroxyl group at the 2- or 3- position cannot be prepared by the prior art processes, the product of Applicant's claim 1 could not have been made by the



skilled artisan and therefore could not have been obvious to the skilled artisan. For an obviousness rejection to be proper, the cited prior art must be sufficient for the skilled artisan to produce the claimed product, which is not the case in this instance. The Examiner is requested to carefully consider the information set forth in the enclosed 132 Declaration, explaining why the product of amended claim 1 could not have been obvious to the skilled artisan. The required deuterated alcohol for the esterification reaction was unknown prior to the present Applicant's invention.

In view of the above, reconsideration and allowance are now believed to be in order, and are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the listed telephone number.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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